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EXAMINER

DANG, ANH TIEU

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM D. FOX

Appeal 2015-002524
Application 12/359,824
Technology Center 3700

Before EDWARD A. BROWN, JAMES P. CALVE, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the final rejection of claims 1, 3–14, and 21–34. Br. 5. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Claims 1, 10, 22, and 29 are independent. Claim 1 is reproduced below.

1. A transluminal access device, comprising:
 - a flexible cannula defining a first lumen, the cannula comprising a distal end and a proximal end, wherein the cannula is movable longitudinally in a distal direction and a proximal direction relative to a handle assembly, the cannula sized for insertion into a working channel of an endoscope;
 - a flexible rotatable rotary needle positioned within the cannula, the rotary needle defining a second lumen, the rotary needle comprising a distal end and a proximal end, the distal end of the rotary needle defining a distal opening comprising a cutting edge, the rotary needle is rotatably movable relative to the cannula and is longitudinally fixed in relation to the handle assembly such that advancing the cannula in a distal direction effectively retracts the distal end of the rotary needle in the proximal direction and retracting the cannula in the proximal direction exposes the distal end of the rotary needle; and
 - a flexible stylet slidably disposed within the rotary needle, wherein the flexible stylet is selectably continuously movable to any position between a maximum distal position and a maximum proximal position, wherein the movement is independent of a force being applied by a tissue surface.

REJECTIONS

Claims 1, 3–14, and 21–34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conlon (US 2007/0255306 A1, pub. Nov. 1, 2007), Buzzard (US 2004/0193180 A1, pub. Sept. 30, 2004), and Gerry (US 5,409,478, iss. Apr. 25, 1995). Final Act. 8.

Claims 1, 3–14, and 21–34 are provisionally rejected for non-statutory obviousness-type double patenting over claims 1–4, 8–10, 12, 14–17, and 23 of Application No. 12/122,031, Conlon, Buzzard, and Gerry. Final Act. 7.

ANALYSIS

Unpatentability of Claims 1, 3–14, and 21–34 over Conlon, Buzzard, Gerry

Appellant argues claims 1, 3–14, and 21–34 as a group. Br. 14–23. We select claim 1 as representative. 37 C.F.R. § 41.37(c)(1)(iv). Claims 3–14 and 21–34 stand or fall with claim 1.

The Examiner found that Conlon teaches a transluminal access device substantially as recited in independent claims 1, 10, 22, and 29, except for a rotatable and longitudinally movable distal portion of the handle to advance the cannula in a distal direction thereby to retract the distal end of the rotary needle. Final Act. 9–10. The Examiner found that Buzzard teaches a handle assembly that advances and retracts outer sheath 66 via a rotatable wheel 60 to expose or retract the distal end of the rotary needle, as claimed. *Id.* at 10.

The Examiner determined that it would have been obvious to reverse the relative movement of Conlon to advance and retract the cannula distally as a way to retract the distal end of the rotary needle by making endcap 12c rotatable and longitudinally moveable relative to the handle so that rotation of endcap 12c advances cannula 28, which is attached to endcap 12c. *Id.*

Appellant argues that introducing a movable outer sheath of Buzzard onto Conlon would change the principle of operation of Conlon's device that has outer sheath 28 fixed to handle 12, and needle 17 slidably movable with respect to handle 12. Br. 20. Appellant also argues that such modification would require substantial reconstruction and redesign of Conlon's handle 12 and render Conlon's device inoperable by replacing Conlon's fixed outer sheath 28 with Buzzard's movable outer shaft member 66 because Conlon relies on fixed outer sheath 28 to determine the length of needle 17 that is exposed and the penetration depth of needle tip 18. *Id.* at 20–21.

Appellant's arguments are not persuasive for the following reasons. We agree with the Examiner that making Conlon's end cap 12c rotatable and longitudinally movable relative to needle 17, as taught by Buzzard, would not change Conlon's principle of operation. Ans. 2. Contrary to Appellant's argument (Br. 20–21), Conlon does not require a fixed end cap 12c and outer sheath 28 to set/adjust the exposed length of needle 17. Conlon teaches that the length of sheath 28 can vary and sheath 28 is not a necessary component. Conlon ¶ 32. Conlon extends plunger 22 distally of needle tip 18 to prevent unintended cutting and provide a reference point for needle tip 18. *Id.* ¶ 39.

The Examiner proposes to increase the capabilities of Conlon's device by making outer sheath 28 adjustable in a longitudinal direction, as taught by Buzzard, so that a surgeon can expose or cover needle tip 18 by advancing or retracting sheath 28 (the cannula) with a single hand. *See* Final Act. 10–11; Ans. 2–3. Buzzard teaches this advantage of rotatable finger ring 60 to facilitate the single-handed retraction of outer sheath 66 to deliver stent 50. Buzzard ¶ 33. Buzzard uses finger ring 60 to provide precise and sensitive adjustments that complement rapid, large-scale movement via knob 72. *Id.* ¶¶ 13, 14, 33, 43–46. The Examiner's modification of Conlon with such a precision, single-handed adjustment feature similarly would complement Conlon's depth gauge 32, which permits larger-scale displacement of needle 17 and needle tip 18 relative to outer sheath 28 before surgery. Conlon ¶ 36.

Appellant further argues that the Examiner's rationale for modifying Conlon to allow quick, one-handed advancing and retraction of needle 17 by a surgeon is conclusory, lacks a rational underpinning, and uses hindsight. Br. 21–22. These arguments are not persuasive for the following reasons.

The Examiner's reasons are supported by rational underpinning where Buzzard expressly teaches that finger wheel 60 permits the single-handed and precise adjustment of the exposed portion of the tip of the device by a surgeon during a surgical procedure and provides similar improvements to Conlon, as discussed above. Buzzard ¶¶ 14, 33, 43. Appellant's argument that the Examiner's rationale is conclusory (Br. 21–22) does not address the reasons provided by the Examiner (Ans. 4; Final Act. 10) and, therefore, is not persuasive, particularly in view of the teachings of Buzzard relied upon by the Examiner to improve Conlon similarly. The Examiner's reliance on Buzzard's teachings also undermines Appellant's argument that the rejection is based on impermissible hindsight. *See In re Cree*, 818 F.3d 694, 702 n.3 (Fed. Cir. 2016).

Thus, we sustain the rejection of claims 1, 3–14, and 21–34.

Claims 1, 3–14, and 21–34 for obviousness-type double patenting

The Examiner provisionally rejected claims 1, 3–14, and 21–34 for obviousness-type double patenting over claims of U.S. Application No. 12/122,031 in view of Conlon, Buzzard, and Gerry. Final Act. 7. Because U.S. Application No. 12/122,031 was abandoned on July 10, 2014, we reverse the double patenting rejection as moot. *See* MPEP § 804(I)(C) (“If the published application has not yet issued as a patent, the examiner is permitted to make a ‘provisional’ rejection on the ground of double patenting when the published application *has not been abandoned* and claims pending therein conflict with claims of the application being examined.”) (emphasis added).

DECISION

We affirm the rejection of claims 1, 3–14, and 21–34 under 35 U.S.C. § 103(a) as being unpatentable over Conlon, Buzzard, and Gerry.

We reverse, as moot, the provisional obviousness-type double patenting rejection of claims 1, 3–14, and 21–34 over claims of U.S. Application No. 12/122,031, Conlon, Buzzard, and Gerry.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED